

REMARKS

Claims 1-15 are pending. Claims 1-4 were previously withdrawn. Claims 5-9, 10-15 are presently under examination and subject to an election of species requirement as discussed below. Claims 5, 9, 10, and 14 are amended, and new claims 16-18 are presented herein.

Applicant wishes to thank the Examiner for acknowledging the RCE and further thanks are expressed for the withdrawal of the prior rejections under 35 U.S.C. § 102(b) to Finke, La Mers and Wu *et al.*

Requirement for Election of Species

Applicant respectfully traverses the requirement for election of species. The Office Action requires Applicant to elect one of species A, drawn to a bandlike covering or species B drawn to a film. Applicant respectfully asserts that to search the full range of embodiments would not impose any additional burden of searching on the Examiner. As evidence to support this, Applicant notes the wide range of art cited against the claims in the prior Office Action. It is clear that the Examiner previously searched all embodiments and searched numerous analogous and nonanalogous references. Further, as the Examiner has acknowledged, the application contains a generic claim, in that claim 5 is directed to all embodiments. Applicant has presented herewith new claims 16-18. New claim 16 is also a generic claim, which plainly links all of the embodiments in a fashion that may enable the Examiner to gain a more full appreciation of Applicant's invention. Claim 16 is directed to methods for gluing a covering onto a workpiece with an adhesive, said workpiece having a cross sectional surface, the covering being pressed onto the workpiece by means of at least one pressure element wherein the covering is pressed on by means of a pressure element which has an elastically deformable pressure face that deformably matches and exerts uniform pressure on the cross sectional surface independent of the profile of said cross sectional surface, wherein movement of the workpiece along its length, in relation to the pressure element, occurs while the covering is uniformly pressed onto the cross sectional surface.

As can be seen, the claim encompasses the two species identified in the Office Action, however, the claim also makes it clear that subspecies identified are not all proper. The Office Action requires a further species election, for example of species A, wherein the narrow face has a straight cross-section (species Aix) or wherein the narrowed face has a profiled cross-section (species Ai_y). This requirement misses the point of the claim. As claim 16 reflects and claim 5 has been amended to show, the Applicant's pressure element is able to exert uniform pressure on the surface, independent of its shape. Thus, it does not matter whether the profile is straight or curved. The claimed embodiment of the Applicant's invention provides an "elastically deformable pressure face that deformably matches and exerts uniform pressure" with the advantage that it deforms to the surface independent of the profile. This clearly should be withdrawn as a species requirement.

Similarly, the Office requires election to a further species of Aix and Ai_y, in particular, wherein the species is drawn to the deformable face being an elastic band (species Aixa), or wherein the species is drawn to the deformable face being a spring-steel band. The specification notes that the "[i]t is proposed, furthermore, that the deformable pressure face comprise[s] an elastic band, in particular a spring-steel band." (Applicant's specification, page 6, lines 25-28). Thus, there is no need for the requirement for a species election for these embodiments, as the embodiments, while distinct, are not necessarily mutually exclusive in their characteristics. (see MPEP 806.04(f)).

As can be seen from claim 16, a similar argument is present for the requirement for election of species Ai and Aii drawn to board elements and profile bars respectively. As claim 16 demonstrates, the limitations of these two species are not mutually exclusive, in that the method requires a workpiece with a cross sectional surface. (see Applicant's specification at page 6, lines 29-35 supporting "workpiece" limitation). Both profile bars and board elements share the characteristic of having a cross sectional surface, thus the claim is not reciting a mutually exclusive characteristic of the species.

In accordance with the above, Applicant respectfully requests reconsideration of the requirement for species election. To be fully responsive to the requirement, Applicant elects Species Aixa. Claims 5-8, 10-12, and 14-18 read on the elected species. It is Applicant's understanding that this election is being made to aid the Examiner in conducting a search and examination of the claimed subject matter, and is not to be construed as limiting the scope of Applicant's claims. It is also Applicant's understanding that, if the elected subject matter is found to be allowable over the prior art, the search and examination will be expanded to cover other species, until it includes the full scope of the generic claims included in the elected group.

Applicant's representative also notes for the record that he does not have any record of the provisional election asserted in the Office Action, although the elected group is correct.

The Claims Satisfy the Requirements of 35 U.S.C. § 112, second paragraph.

Claims 5-8, 10-12 and 14-15 stand rejected allegedly indefinite under 35 U.S.C. § 112, second paragraph for failing to particularly point out and distinctly claim the invention.

With respect to claim 5, Applicant has clarified that the narrow face applies to the board element and the surface applies to the profile bar. Applicant has also clarified the reference to the cross section of the board element/ profile bar. Applicants has changed the recitation of pressure "head" to pressure element as suggested by the Examiner. This change has also been made in claims 13 and 14.

With respect to claim 10 the antecedent "an" has been inserted before the term "adhesive."

The claims as amended do not contain any of the allegedly indefinite recitations, accordingly the rejections under 35 U.S.C. § 112, second paragraph are moot. Applicant respectfully requests withdrawal of these rejections.

The Claims Are Not Anticipated by Duewel

Claims 5-6, 8, 10-12, and 14-15 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Duewel (U.S. Patent No. 4,222,812). Applicants respectfully traverse this rejection.

The claims are directed to methods for gluing a covering (a bandlike covering or film) onto a workpiece (narrow face of a board element or a surface of a profile bar) with adhesive, wherein the covering or film is pressed onto the surface of the workpiece (e.g. the narrow face of the board element or surface of the profile bar) by means of at least one pressure element wherein the covering or film is pressed on by means of a pressure element which has *an elastically deformable pressure face that deformably matches and exerts uniform pressure independent of the shape* of the profile of the workpiece (narrow face of the board element or the surface of the profile bar), wherein movement of the board element or profile bar along its length, in relation to the pressure element, occurs while the covering is uniformly pressed onto the narrow face.

Duewel teaches no such pressure element. Duewel does not teach that uniform pressure is important – he does not even suggest it. Duewel was trying to solve the problem of overheating the glue and scorching, and of requiring a skilled operator to move the workpiece at a constant rate. Duewel did not consider uniform pressure. The spindle of Duewel cannot be said to inherently provide uniform pressure, as the pressure would necessarily vary from the bottom to the top of the spindle because of the ability of the spindle to float.

Further Duewel never remotely considered any profile other than a straight profile with true edges. At Column 6, lines 47-49 Duewel states [thus] the panel *edge* and web are *always received within a working recess* defined by the flange 85 of the spool and the slip ring 93, which rotate as a unit and insure alignment of the web along the edge. Without a straight surface and flat edge, there can be no alignment with the device of Duewel. It is clearly required and would preclude the use of many profiles, for example rounded or

bullnose type profiles. This is further confirmed in the next paragraph wherein it states “The spindle 18 is *adjusted to accommodate the particular panel and web* between the top flange 85 and the slip ring 93.” Thus, for the device to operate the operator must adjust the pressure element even to accommodate different board elements with straight profiles.

In contrast, the Applicant’s pressure element elastically deforms to match the profile independent of its shape. Even assuming *arguendo* that the sleeve 86 is sufficiently resilient to allow the spindle to elastically adapt to some slightly curved or rounded profile, it is impossible to say that it could do so independent of shape, and further it cannot be said that such an arrangement would necessarily exert uniform pressure across the profile. Far more likely, given the design of Duewel’s (inelastic) spindle with but a resilient sleeve, is that it could not adapt to any profile other than straight because the edge required by the flange 15 would not be present or would not be sufficient to result in proper alignment of the edge band with the edge. The cited resiliency of Duewel’s sleeve is in no way the same as the properties of Applicant’s claimed pressure element and could not confer the ability to deformably match and exert uniform pressure of the shape of the workpiece.

Applicant respectfully asserts that claim 5, and thus all claims dependent therefrom are in fact patentable over the teachings of Duewel. Reconsideration is respectfully requested, as is withdrawal of the rejection under 35 U.S.C. § 102(b).

The Claims are Not Obvious Over the Cited References

Claim 7 stands rejected as allegedly not patentable over Duewel as applied to claim 5 and further in view of PCT W 99/58307. Applicant respectfully traverses this rejection.

Duewel does not teach the pressure element required to practice the method of the instant claims as discussed above. It matters not whether the PCT publication teaches chipboard, fiberboard or solid wood boards. Because references, singly or in combination do not teach each and every element of the claimed invention, the *prima facie* case has been rebutted and the rejection under 35 U.S.C. § 103 must be withdrawn. Applicant respectfully requests reconsideration and withdrawal of the rejection accordingly.

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Conclusion:

The amendments and remarks herein are believed to be fully responsive to the Office Action. Applicant respectfully asserts that all claims are now in condition for allowance. An early and favorable Notice to that end is earnestly solicited. To resolve any outstanding issues prior to allowance of the claims, the Examiner is invited to contact the Applicant's undersigned representative by email at sscioli@woodcock.com, by telephone at 215-557-5986, or by facsimile at 215-568-3439.

Respectfully submitted,

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